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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS R. MARSH and ROBERT C. HIGHTOWER

Appeal 2009-002009
Application 10/820,186
Technology Center 3600

Decided: March 15, 2010

Before: WILLIAM F. PATE III, JOHN C. KERINS, and
KEN B. BARRETT, *Administrative Patent Judges*.

PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1, 4-11, 13 and 14. These are the only claims remaining in the application. We have jurisdiction over the appeal under 35 U.S.C. §§ 134 and 6.

The claimed subject matter is directed to a device for protecting and cushioning first and second confronting furniture components. The device has a base member with a cushioning member thereon and a clip connected to the base member, the clip having first and second members. The claims are further directed to a combination of the device with an article of furniture.

Claim 1 and claim 5, reproduced below, are further illustrative of the claimed subject matter.

1. An article of furniture, comprising:

first and second confronting furniture components, wherein one of the first and second furniture components comprises a frame and the other of the first and second furniture components comprises a movable member connected with the frame and movable from an open position to a closed position; and

a device for protecting the first and second confronting furniture components, the device comprising:

a base member having opposite first and second faces, the first face adapted to contact the first furniture component, the base member having a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member, the projection adapted to contact the second furniture component as it confronts the first furniture component; and

a clip connected to the base member, the clip having a first member attached to one end portion of the base member and a second member attached to the first member, the base member, first member and second member defining a cavity within which one of the first or second furniture components is captured to affix the

device thereto, wherein the device is formed as a unitary member and is entirely formed of a polymeric material.

5. A device for protecting first and second confronting furniture components, the device comprising:

a base member having opposite first and second faces, the first face adapted to contact the first furniture component, the base member having a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member, the projection adapted to contact the second furniture component as it confronts the first furniture component, wherein the projection has a convex portion extending outwardly from the second face of the base member and a planar portion opposite the convex portion, and the planar portion of the projection has a thickness that is less than the thickness of the base member

REFERENCES

The references of record relied upon by the examiner as evidence of anticipation and obviousness are:

Schanz	US 1,998,791	Apr. 23, 1935
Tinnerman	US 2,185,161	Dec. 26, 1939
McEvoy	US 2,858,583	Nov. 4, 1958
McAlarney	US 3,952,455	Apr. 27, 1976
Wilson	US 6,148,584	Nov. 21, 2000

REJECTIONS

Claims 1, 4, 6-11, 13 and 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over McAlarney.

Claims 1, 4 and 6-11 stand rejected under 35 U.S.C. § 103(a) as

unpatentable over Tinnerman in view of Schanz.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over McAlarney in view of McEvoy.

Claim 5 stands rejected under 35 U.S.C. § 102(b) as anticipated by McEvoy.

Claims 13 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Tinnerman in view of Schanz and Wilson.

ISSUES

Appellants argue that claims 1, 4, 6-11, 13 and 14 are not unpatentable over McAlarney, because McAlarney does not disclose capturing the first or second furniture component in the clip portion of the protection device. Therefore, the issue for consideration is whether the Examiner has established that McAlarney discloses a clip which captures a first or second furniture component.

With respect to claims 1, 4 and 6-11, rejected under § 103(a) as unpatentable over Tinnerman in view of Schanz, Appellants argue that neither Tinnerman nor Schanz discloses a clip portion which is attached to one end of the base. Therefore, the issue for our consideration is whether Tinnerman or Schanz discloses a clip with a first member connected to one end of the base member.

With respect to the rejection of claim 5 under § 102 and § 103 over McEvoy or the combined teachings of McAlarney in view of McEvoy, Appellants argue that neither reference shows a base member with a projection that has a convex portion and a planar portion opposite the convex portion wherein the planar portion has a thickness that is less than

the thickness of the base member. Therefore, the issue for consideration is whether McEvoy teaches or the combined teachings of McAlarney and McEvoy render obvious a base portion with a portion opposite the convex portion that is both planar and of less thickness than the remaining portion of the base.

Finally, with respect to claim 13, Appellants again argue that neither Tinnerman, Schanz, nor Wilson discloses a clip member with a first member that is attached to one end of the base member. Therefore, with respect to claim 13, the issue is whether the Examiner has established that Tinnerman, Schanz, and Wilson render obvious the claim limitation of a base member with a clip that has a first member attached to the end of the base member.

FINDINGS OF FACT

McAlarney discloses an article of furniture, a first frame portion 1 and a second confronting movable portion 2 and a device therebetween for protecting the first and second confronting furniture components. The device comprises a base 20 with a clip 21, 23, 25, extending away from one end portion of the base member. See col. 3, l. 64 – col. 4, l. 16. While McAlarney does disclose a clip member, this clip member is used to hold the device to the movable portion of the furniture by a holding strip 16 which covers and holds the fastening rib 25 which is mounted to the second member of the clip. Therefore, it is our finding that the clip 21, 23, and 25 does not capture a first or second furniture component. See *id.* and col. 3, ll. 22-39.

Tinnerman discloses a compressible rubber sealing strip C between the door and the door frame or casing. See Figs. 1 and 2. From the Figures

it can be seen that sealing strip C has a circular sealing portion with an angled L-shaped flange abutting wall member B of the furniture. See Tinnerman, pg. 1, col. 2, ll. 38-45.

Schanz discloses a sealing strip to seal and cushion between furniture members 10 and 11. Schanz discloses a base member with a convex sealing portion 14, a clip member comprising a stem 15 and a pair of rearwardly extending retaining lips 16, 16'. See Schanz col. 1, ll. 31-43. The clip 15, 16, 16' is attached to the center of the base member.

McEvoy discloses a device for protecting first and second confronting components having a base member 26 with a convex cushioning projection 25. Base member 26 contacts the first component and cushioning projection 25 contacts the second component. As seen in Fig. 2b, base portion 26 opposite the convex cushioning projection 25 has a planar portion (unnumbered) with a thickness that is less than the thickness of the base member at either side of the projection. Col. 2, ll. 64-68. In Fig. 2b, the planar portion appears to be comprised of two planar faces that extend at slight angles to the horizontal and meet at an apex that further defines this inner, planar portion.

A dictionary definition of planar is: of, pertaining to, or situated in a plane. Flat. *American Heritage Dictionary of the English Language, New College Edition*, 1976, p. 1002.

Wilson has been cited by the Examiner to show a planar portion extending away from the cushioning projection.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103). Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions, or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). Rejections on obviousness grounds must be supported by “some articulated reasoning with some rational underpinning” to combine the known elements in the manner required in the claim at issue. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

The prior art may anticipate a claimed invention, and thereby render it non-novel, either expressly or inherently. *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). Express anticipation occurs when the prior art expressly discloses each limitation (i.e., each element) of a claim. *Id.* In addition, “[i]t is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it.” *Id.*

ANALYSIS

As our Findings make clear, with respect to the McAlarney reference, we do not find therein any structure defining a cavity within which one of the first or second furniture components is captured to affix the device thereto, as required by claim 1 and claim 13. Therefore, the rejection of claims 1, 4, 6-11, 13 and 14 under § 103 as unpatentable over McAlarney is reversed.

With respect to Tinnerman and Schanz, Tinnerman does not disclose a clip member. Schanz discloses a clip member but the clip member is not attached to one end of the base member. Instead, the clip member of Schanz is attached to the center of the base member. Therefore, the combined teachings of Tinnerman and Schanz do not render the subject matter of claims 1, 4, and 6-11 *prima facie* obvious. The Wilson reference adds nothing in regard to this missing feature of the claimed subject matter and the rejection of claim 13 as unpatentable over Tinnerman in view of Schanz and Wilson is also reversed.

Turning to the rejection of claim 5 under 35 U.S.C. § 102 as anticipated by McEvoy, and as unpatentable over McAlarney in view of McEvoy, we will affirm this rejection. As noted above, the dictionary definition of “planar” is flat. We regard the two sloping interior surfaces on the top of the base member opposite the convex portion in McEvoy Figure 2b as flat surfaces albeit not horizontal. Since these surfaces are flat, they are within the broadest reasonable interpretation of the claim term “planar.” Therefore, we affirm the rejection of claim 5 as anticipated by McEvoy and the rejection of claim 5 as unpatentable over McEvoy in view of McAlarney, anticipation being the epitome of obviousness.

CONCLUSIONS

The Examiner has failed to establish the obviousness of claims 1, 4, 6-11, 13 and 14 as unpatentable over McAlarney

The Examiner has failed to failed to establish that claims 1, 4, 6 and 11 are unpatentable under § 103 over the combined teachings of Tinnerman and Schanz.

The Examiner has failed to establish that the subject matter of claim 13 is obvious over the combined teachings of Tinnerman, Schanz and Wilson.

The Examiner has established that the subject matter of claim 5 is anticipated by McEvoy, and is unpatentable over McAlarney in view of McEvoy, anticipation being the epitome of obviousness.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED-IN-PART

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